

In re Application of:

Docket No. 03500.015536

AT&T  
YOSHITAKI SHINO, ET AL.

Application No.: 09/900,008

Examiner: T. Dicus

Filed: July 9, 2001

Group Art Unit: 1774

For: NON-CONTACT INFORMATION RECORDING  
MEDIUM FOR INK-JET RECORDING AND  
IMAGE FORMING PROCESS

Date: February 2, 2005

MAIL STOP AF  
COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is an Amendment in the above-identified application.

No additional fee is required.

The fee has been calculated as shown below

CLAIMS AS AMENDED						
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDITIONAL FEE
TOTAL CLAIMS	22	MINUS	20	2	x \$25 \$50	\$100.00
INDEP. CLAIMS	4	MINUS	4	0	x\$100 \$200	0.00
Fee for Multiple Dependent claims \$180/\$360						
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$100.00

A Verified Statement claiming small entity status is enclosed, if not filed previously.

A check in the amount of \$100.00 is enclosed.

02/10/2005 EHARDY 00000001 061205  
01 FC:1202 100.00 DA  
02/10/2005 EHARDY 05/09/2005 SDIRETAL  
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01 FC:1202 100.00 CR  
01 FC:1202

Page 1 of 2

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100M #800N

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03500.015536.

## PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

2005 APR -1 PM 12:



Re Application of:  
OSHIYUKI SHINO ET AL.  
Application No.: 09/900,008  
Filed: July 9, 2001  
For: NON-CONTACT INFORMATION  
RECORDING MEDIUM FOR  
INK-JET RECORDING AND  
IMAGE FORMING PROCESS  
Examiner: T. Dicus  
Group Art Unit: 1774  
March 29, 2005

Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450

## REQUEST FOR REFUND

Sir:

In connection with the above-identified application, Applicants request a refund of \$100.00 for claims in excess of twenty, which was erroneously charged to our Deposit Account 06-1205. It is requested that the refund be applied as a credit to that Deposit Account. The reason for the refund is explained below.

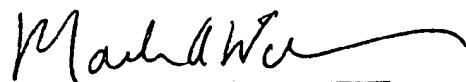
On February 2, 2005, Applicants filed an Amendment After Final Rejection with transmittal. A copy of the Amendment, Transmittal and return receipt postcard are attached. At that time, Applicants paid a claims fee of \$100.00. No additional fee was due at that time.

The Patent Office's Monthly Statement of Deposit Account, dated February 2005 (copy attached), indicates that Deposit Account No. 06-1205 was charged a fee of \$100.00. Therefore, Applicants respectfully submit that a refund of \$100.00 is due.

Accordingly, Applicants hereby request a refund and authorize the Commissioner to credit Deposit Account No. 06-1205 in the amount of \$100.00.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our New York office at the below listed address.

Respectfully submitted,

  
\_\_\_\_\_  
Mark A. Williamson  
Attorney for Applicants  
Registration No. 33,628

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-3801  
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NY\_MAIN 488683v1



Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Date 2/2/05  
Mo. Day Yr.

Atty. Docket 03502.015336

Application No D9/900,008

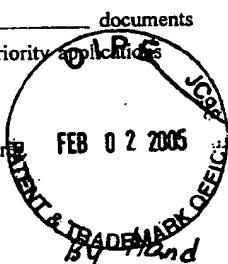
Sir:

Kindly acknowledge receipt of the accompanying:

- Response to Official Action, mailed 11/2/2004  
 Check for \$ 100-00 (claims fee)  
 Petition under 37 CFR 1.136 and Check for \$ \_\_\_\_\_  
 Notice of Appeal and Check for \$ \_\_\_\_\_  
 Information Disclosure Statement, PTO-1449 and \_\_\_\_\_ documents  
 Claim for priority and certified copies of \_\_\_\_\_ priority applications  
 Issue fee transmittal and Check for \$ \_\_\_\_\_  
 Other (specify) Transmit Mail

by placing your receiving date stamp hereon and returning to delivery.

Atty. MARO:jab Due Date 2/2/05  
Mo. Day Yr.





In re Application of  
YOSHIYUKI SHINO, ET AL.

Docket No. 03500.015536

Application No.: 09/900,008

Examiner: T. Dicus

Filed: July 9, 2001

Group Art Unit: 1774

For: NON-CONTACT INFORMATION RECORDING  
MEDIUM FOR INK-JET RECORDING AND  
IMAGE FORMING PROCESS

Date: February 2, 2005

MAIL STOP AF  
COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is an Amendment in the above-identified application.

No additional fee is required.

The fee has been calculated as shown below

CLAIMS AS AMENDED						
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDITIONAL FEE
TOTAL CLAIMS	22	MINUS	20	2	x \$25 \$50	\$100.00
INDEP. CLAIMS	4	MINUS	4	0	x\$100 \$200	0.00
Fee for Multiple Dependent claims \$180/\$360						
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT—						\$100.00

°Verified Statement claiming small entity status is enclosed, if not filed previously.

A check in the amount of \$100.00 is enclosed.

- Charge \$\_\_\_\_ to Deposit Account No. 06-1205. A duplicate of this sheet is enclosed.
- Any prior general authorization to charge an issue fee under 37 C.F.R. 1.18 to Deposit Account No. 06-1205 is hereby revoked. The Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. 1.16 and 1.17 which may be required during the entire pendency of this application, or to credit any overpayment, to Deposit Account No. 06-1205. A duplicate of this paper is enclosed.
- A check in the amount of \$\_\_\_\_ to cover the fee for a \_\_\_\_ month extension is enclosed.
- A check in the amount of \$\_\_\_\_ to cover the Information Disclosure Statement fee is enclosed.
- Applicants' undersigned attorney may be reached in our Washington office by telephone at (202) 530-1010. All correspondence should be directed to our address given below.



Mark A. Williamson  
Attorney for Applicants  
Reg. No. 33,628

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JMC:jab

DC\_MAIN 191878v1



**AMENDMENT UNDER 37 C.F.R. § 1.116  
EXPEDITED PROCEDURE  
EXAMINING GROUP 1774**

03500.015536

## **PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**In re Application of:**

YOSHIYUKI SHINO, et al.

Appln. No.: 09/900,008

Filed: July 9, 2001

For: NON-CONTACT INFORMATION RECORDING MEDIUM FOR INK-JET RECORDING AND IMAGE FORMING PROCESS

**MAIL STOP AF**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

## **AMENDMENT AFTER FINAL REJECTION**

Sir:

In response to the final Office Action dated November 2, 2004, in the above-identified application, Applicants respectfully submit the following amendments and remarks.

IN THE CLAIMS:

Please cancel Claims 9-13 without prejudice or disclaimer of the subject matter recited therein.

Please amend Claims 14 and 18 and add new Claims 23 and 24, as follows.

Claims 1-13 (Cancelled)

14. (Currently Amended) An information recording medium comprising an electronic information storing circuit part, a base material and an ink receiving layer comprising a water-soluble or hydrophilic synthetic resin, in this order, and further comprising a barrier layer for preventing ink components applied to the ink receiving layer from reaching the electronic information storing circuit part and having a concentration of ionic chlorine of 100 ppm or less, wherein the barrier layer is provided between the electronic information storing circuit part and the base material so as to prevent an ink applied to the ink receiving layer from reaching the electronic information storing circuit part.

15. (Previously Presented) The information recording medium according to claim 14, wherein the barrier layer has an air permeability of at least 300 sec/100 cc as measured in accordance with the Gurley air permeability testing method.

16. (Previously Presented) The information recording medium according to claim 14, wherein the barrier layer has a thickness of 0.5 to 20  $\mu\text{m}$ .

17. (Cancelled)

18. (Currently Amended) An information recording medium comprising an electronic information storing circuit part[.] and an ink receiving layer comprising a water-soluble or hydrophilic synthetic resin, in this order, and further comprising a barrier layer for preventing ink components applied with an ink jet head to the ink receiving layer from reaching the electronic information storing circuit part and having a concentration of ionic chlorine of 100 ppm or less,

wherein the barrier layer is provided between the electronic information storing circuit part and the ink receiving layer so as to prevent an ink applied with an ink jet head to the ink receiving layer from reaching the electronic information storing circuit part.

19. (Previously Presented) The information recording medium according to claim 18, wherein the barrier layer has an air permeability of at least 300 sec/100 cc as measured in accordance with the Gurley air permeability testing method.

20. (Previously Presented) The information recording medium according to Claim 14, wherein ink-jet recording can be carried out on the recording medium.

21. (Previously Presented) The information recording medium according to Claim 14, wherein the recording medium is used as a non-contact tag.

22. (Previously Presented) The information recording medium according to claim 18, wherein the barrier layer comprises a silicon-modified organic high-molecular weight compound or an epoxy resin composition.

23. (New) An information recording medium comprising an electronic information storing circuit part, a base material and an ink receiving layer comprising a water-soluble or hydrophilic synthetic resin, in this order, and further comprising a barrier layer for preventing ink components applied to the ink receiving layer from reaching the electronic information storing circuit part,

wherein the barrier layer is provided between the electronic information storing circuit part and the base material.

24. (New) The information recording medium according to Claim 23, wherein the ink receiving layer contains inorganic fine particles.

25. (New) The information recording medium according to Claim 23, wherein the ink receiving layer contains a cationic compound.

26. (New) The information recording medium according to Claim 23, wherein the ink receiving layer has a thickness of 1 to 100  $\mu\text{m}$ .

27. (New) The information recording medium according to Claim 23,  
wherein an adhesive layer and a releasing layer are provided on a surface of the base material  
other than that on which the ink receiving layer is provided.

28. (New) The information recording medium according to Claim 23,  
wherein said medium is in the form of cut sheets.

29. (New) The information recording medium according to Claim 23,  
wherein said medium is in the form of a roll.

30. (New) An information recording medium comprising an electronic  
information storing circuit part and an ink receiving layer, in this order, and further comprising a  
barrier layer which is a base material composed of a water-repellent material,  
wherein the barrier layer is provided between the electronic information storing  
circuit part and the ink receiving layer so as to prevent an ink applied with an ink jet head to the  
ink receiving layer from reaching the electronic information storing circuit part.

31. (New) The information recording medium according to Claim 30,  
wherein the ink receiving layer contains inorganic fine particles.

32. (New) The information recording medium according to Claim 30,  
wherein the ink receiving layer contains a cationic compound.

33. (New) The information recording medium according to Claim 30,  
wherein the ink receiving layer has a thickness of 1 to 100 µm.

34. (New) The information recording medium according to Claim 30,  
wherein an adhesive layer and a releasing layer are provided on a surface of the base material  
other than that on which the ink receiving layer is provided.

35. (New) The information recording medium according to Claim 30,  
wherein said medium is in the form of cut sheets.

36. (New) The information recording medium according to Claim 30,  
wherein said medium is in the form of a roll.

REMARKS

Favorable consideration and allowance of the subject application are respectfully solicited in view of the foregoing amendments and the following remarks.

Claims 14-16 and 18-36 are pending in this application, with Claims 14, 18, 23 and 30 being independent. Claims 9-13, which have been withdrawn from consideration, have been cancelled. Claims 14 and 18 are amended herein. Claims 23-36 are newly added. Support for the amended and newly added claims can be found in the specification at least at page 17, lines 1 and 2 and page 13, lines 10 and 11. Of course, the claims are not intended to be limited in scope to these preferred embodiments. It is submitted that no new matter has been added by the amendments herein.

Claims 14-16 and 18-22 were rejected under 35 U.S.C. § 103(a), as being obvious over U.S. Patent No. 4,841,134 (Hida, et al.) in view of U.S. Patent No. 5,254,525 (Nakajima, et al.) and further in view of U.S. Patent No. 5,786,055 (Sei, et al.). This rejection is respectfully traversed.

As recited in independent Claim 23, the present invention relates to an information recording medium comprising an electronic information storing circuit part, a base material and an ink receiving layer comprising a water-soluble or hydrophilic synthetic resin, in this order, and further comprising a barrier layer for preventing ink components applied to the ink receiving layer from reaching the electronic information storing circuit part. The barrier layer is provided between the electronic information storing circuit part and the base material

Independent Claim 14 is similar to independent Claim 23, but further recites that the barrier layer has a concentration of ionic chlorine of 100 ppm or less.

As recited in independent Claim 18, the present invention relates to an information recording medium comprising an electronic information storing circuit part and an ink receiving layer comprising a water-soluble or hydrophilic synthetic resin, in this order, and further comprising a barrier layer for preventing ink components applied with an ink jet head to the ink receiving layer from reaching the electronic information storing circuit part and having a concentration of ionic chlorine of 100 ppm or less. The barrier layer is provided between the electronic information storing circuit part and the ink receiving layer.

As recited in independent Claim 20, the present invention relates to an information recording medium comprising an electronic information storing circuit part and an ink receiving layer, in this order, and further comprising a barrier layer which is a base material composed of a water-repellent material. The barrier layer is provided between the electronic information storing circuit part and the ink receiving layer so as to prevent an ink applied with an ink jet head to the ink receiving layer from reaching the electronic information storing circuit part.

Hida et al. relates to an IC card in which an IC module is embedded in a card substrate. Referring to Figure 1a, for example, IC module 4 is embedded through an adhesive layer 6 in a card substrate 3, which includes a laminate of center cores 1a, 1b and oversheets 2a, 2b. IC module 4 has a reinforcing member 5 that comprises a side portion of the IC module substrate. Between center core 1b and oversheet 2b, a reinforcing sheet layer 8 is formed. While Hida, et al. does suggest that printing can be provided on the backside of the card, the Examiner recognizes that Hida et al. does not disclose an ink receiving layer. Accordingly, Hida et al. cannot disclose or suggest an electronic information storing circuit part, a base material and an

ink receiving layer, with a barrier layer provided between the circuit part and the base material, as is recited in independent Claims 14 and 23. Nor does Hida et al. disclose or suggest an electronic information storing circuit part and an ink receiving layer, with a barrier layer provided between the circuit part and the ink receiving layer, as is recited in independent Claims 18 and 30.

Furthermore, although the Examiner suggests that in Hida et al. the component order is IC module 4-adhesive 6-reinforcing member 5-oversheet 2b, it is respectfully submitted that reinforcing member 5 is not depicted as being provided between adhesive 6 and oversheet 2b in any embodiment. Moreover, Applicants submit that in the structure of Hida et al., the substrate and adhesive layer do not completely cover the IC module and the IC module is exposed. Accordingly, one attribute of the present invention cannot be achieved by Hida et al., namely, because the IC module is exposed in Hida et al., prevention of circuit problems caused by ink cannot be achieved. In addition, since the oversheet comprises polyvinyl chloride (note column 11, line 60), which contains chlorine, circuit problems may occur even without ink jet recording.

Hida et al. fails to disclose or suggest important features of the present invention recited in the independent claims.

Nakajima et al. relates to a thermal transfer image recording material for an ID card. As understood by Applicants, the ID card of Nakajima et al. is of the sublimating thermal transfer recording type provided with a barrier layer comprising a hydrophilic binder and the like to prevent blur of colorants (note column 15, lines 23-27). Since the barrier layer in Nakajima et al. includes a hydrophilic (i.e., water-absorptive) binder such as gelatin and casein, if such were used as a barrier between an ink receiving layer and a circuit part, the barrier would absorb a

large amount of remaining ink components from an unfixed portion. Thus, such a layer would not have the barrier effect that the present invention can achieve in avoiding circuit problems caused by ink. Nakajima et al. cannot be said to disclose or suggest a barrier layer for preventing ink components applied to an ink receiving layer from reaching an electronic information storing circuit part, as is recited in dependent Claims 14, 18 and 23. Nor does Nakajima et al. disclose or suggest a barrier layer which is a base material composed of a water-repellant material, as is recited in independent Claim 30.

Furthermore, the image receiving layer in Nakajima et al. comprises a heat-resistant resin such as polyvinyl chloride resin, polyester resin, polycarbonate resin and acrylic resin (note column 11, lines 13-17). Applicants submit that these resins are not water-absorbent so that ink-jet recorded images cannot be formed thereon. Accordingly, Nakajima et al. also fails to disclose or suggest an ink receiving layer comprising a water-soluble or hydrophilic synthetic resin, as is recited in independent Claims 14, 18 and 23.

Nakajima et al. fails to remedy the deficiencies of Hida et al. noted above with respect to the independent claims.

Sei et al. relates to an adhesive for semiconductor devices and was cited by the Examiner for teaching removing chloride ions in order to improve electrical insulation reliability. However, Sei et al. is not believed to remedy the deficiencies of the citations noted above with respect to the independent claims.

In view of the foregoing, reconsideration and withdrawal of the § 103 rejection are requested.

Applicants submit that the present invention is patentably defined by independent Claims 14, 18, 23 and 30. The dependent claims are allowable for the reasons given with respect to their respective independent claims, as well as for the patentable features recited therein. Individual consideration of the dependent claims is respectfully solicited.

Applicants also respectfully request that this Amendment After Final be entered. This Amendment was not presented earlier as it was earnestly believed that the claims on file would be found allowable. Given the Examiner's familiarity with the application, Applicants believe that a full understanding and consideration of this Amendment would not require undue time or effort by the Examiner. Moreover, Applicants submit that this Amendment places the application in condition for allowance. Accordingly, entry of this Amendment is believed to be appropriate and such entry is respectfully requested.

Applicants submit that this application is in condition for allowance. Withdrawal of the above-noted rejection, rejoinder of the withdrawn claims and issuance of a Notice of Allowance are respectfully requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



Mark A. Williamson  
Attorney for Applicants  
Registration No. 33,628

FITZPATRICK, CELLA, HARPER & SCINTO  
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*JMC/jab*

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Patent and  
Trademark Office**

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**Deposit Account Statement**

**Requested Statement Month:** February 2005  
**Deposit Account Number:** 061205  
**Name:** FITZPATRICK CELLA HARPER & SCINTO  
**Attention:**  
**Address:** 30 ROCKEFELLER PLAZA  
**City:** NEW YORK  
**State:** NY  
**Zip:** 10112-3801

DATE	SEQ	POSTING REF	ATTORNEY DOCKET NBR	FEE CODE	AMT	BAL
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## Deposit Account Statement

Page 2 of 4

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## Deposit Account Statement

Page 3 of 4

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02/18	245	10775086	03068.001000.PC- WEO	8007	\$20.00	\$28,74	
02/18	681	76431963	2208.T12	7004	\$300.00	\$28,44	
02/18	698	76431962	2208.T13	7004	\$300.00	\$28,14	
02/22	2	09726404	862.C2066	1201	\$200.00	\$27,94	
02/22	3	09726404	862.C2066	1202	\$250.00	\$27,69	
02/22	16	10219242	03500.016628	1202	-\$306.00	\$27,99	
02/22	40	10775086	03068.001000	8021	\$40.00	\$27,95	
02/22	90	60537329	01997.032500	8021	\$40.00	\$27,91	
02/22	2260	78571987	01515.601100	7001	\$325.00	\$27,59	
02/23	53	29217856	00946.006047-TO'SULLIVAN	8007	\$240.00	\$27,35	
02/23	79	09441294	00169.001516	1806	\$180.00	\$27,17	
02/23	90	11033735	00684.103701	9204	-\$220.00	\$27,39	
02/23	109	11060654	00684.519453	1203	\$50.00	\$27,34	
02/23	547	1879843	3285.40.US	7205	\$100.00	\$27,24	
02/23	548	1879843	3285.40.US	7201	\$400.00	\$26,84	
02/24	4	PCT/US05/01384	01997.032500.	1703	-\$280.00	\$27,12	
02/24	4	10403282	02910.000044	1202	\$144.00	\$26,97	
02/24	6	PCT/US05/01384	01997.032500.	1703	\$268.00	\$26,70	
02/24	50	09840116	35.C15325	1801	\$20.00	\$26,68	
02/24	55	10193199	03500.015039	1203	\$30.00	\$26,65	
02/24	57	10193199	03500.015039	1251	\$120.00	\$26,53	
02/24	266	76111507	2782.T6	7004	\$150.00	\$26,38	
02/24	294	10991429	01741002065	8021	\$40.00	\$26,34	
02/24	468	2229546	01873.000025.	7205	\$100.00	\$26,24	
02/24	469	2229546	01873.000025.	7208	\$200.00	\$26,04	
02/24	548	10524831	03500.017684	1633	\$60.00	\$25,98	
02/24	550	10524831	03500.017684	8021	\$40.00	\$25,94	
02/24	939	78573697	01722.T46	7001	\$325.00	\$25,62	
02/24	977	78573728	01722.T47	7001	\$325.00	\$25,29	
02/25	18	11018392	01807.113522	2011	\$20.00	\$25,27	
02/25	20	11018392		2111	\$250.00	\$25,02	
02/25	21	11018392		2311	\$100.00	\$24,92	
02/25	22	11018392		2202	\$225.00	\$24,70	
02/25	23	11018392		2203	\$180.00	\$24,52	
02/25	24	11018392		2051	\$65.00	\$24,45	
02/28	1	10693104	00862.023280	1201	\$200.00	\$24,25	
02/28	2	09742413	35.C15009	1201	\$86.00	\$24,17	
02/28	4	09984705	00862.022424	1251	\$120.00	\$24,05	
02/28	20	11030952	00862.102660	1504	\$300.00	\$23,75	
02/28	83	60639804	02618.401000	8021	\$40.00	\$23,71	
02/28	276	78287296	01628.603300	7004	\$150.00	\$23,56	
02/28	1849	78576295	03068.00T500	7001	\$325.00	\$23,23	
02/28	2042	76468434	0648B.00T108.	7004	\$450.00	\$22,78	

START

SUM OF

SUM OF

END

Deposit Account Statement

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BALANCE	CHARGES	REPLENISH BALANCE
\$15,278.00	\$17,581.00	\$25,091.00 \$22,788.00

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